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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,362	10/14/2003	Joseph A. Zupanick	067083.0283	9284

26231 7590 06/27/2005

FISH & RICHARDSON P.C.  
1717 MAIN STREET  
SUITE 5000  
DALLAS, TX 75201

EXAMINER
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STEPHENSON, DANIEL P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/687,362

Applicant(s)

ZUPANICK, JOSEPH A.

Examiner

Daniel P. Stephenson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/2/05</u> | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24, 25 and 38 of U.S. Patent No. 6,412,556.

Although the conflicting claims are not identical, they are not patentably distinct from each other because although the method of claims 1-15 of the current invention is for preventing formation of sludge in a subterranean cavity, it has the same steps as the method for removing particulate laden fluid of '556's claim 38. With regards to claims 18-20 removal of limitations does not the present invention patentably distinct from the '556 document's claim 38. With regards to claims 16 and 17, they are not patentably distinct from claims 24 and 25 respectively, because removal of limitations does not make the present invention patentably distinct.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 9, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hillger. Hillger discloses a method for removing particulate laden fluid in which a downhole device is positioned. The device contains a downhole pump (7) and an agitator (29). The agitator agitates the fluid as it is being pumped out of the downhole cavity.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Carden. Carden discloses a method for removing particulate laden fluid in which a downhole device is positioned. The device contains an agitator (10). The agitator agitates the fluid as it is being removed from the downhole cavity.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carden in view of Fields. Carden shows all the limitations of the claimed invention, except, it does not disclose that there are extendable blunt arms on the agitator nor does it disclose that the device is placed in the wellbore through a first diameter and expands beyond this diameter. Fields discloses an agitator (188) for a wellbore that comprises a plurality of blunt arms that extend and rotate to agitate particle laden fluid within a downhole cavity. They are placed downhole through a wellbore with a first diameter and expanded beyond this diameter. It would

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have been obvious to one of ordinary skill in the art at the time the invention was made to use the agitator of Field with the apparatus of Carden. This would be done so that different sized cavities could be cleaned with the apparatus.

8. Claims 9, 10 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carden in view of Hillger and Fields. Carden shows all the limitations of the claimed invention, except, it does not show that there is a pump attached to the agitator nor does it show that there are extendable blunt arms on the agitator. Hillger discloses a pump attached to an agitator for removing particulate laden fluids. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pump of Hillger on the apparatus of Carden. This would be done so that the apparatus of Carden did not rely solely upon well pressure for the removal of particulate laden fluid. Fields discloses an agitator for a wellbore that comprises a plurality of blunt arms that extend and rotate to agitate particle laden fluid within a downhole cavity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the agitator of Field with the apparatus of Carden in view of Hillger. This would be done so that different sized cavities could be cleaned with the apparatus.

With regards to claim 16, it is Officially Noticed that it is notoriously conventional to use a variety of pumps in the wellbore art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a suction rod pump on the apparatus of Carden in view of Hillger and Fields. This would be done to allow for greater suction of fluid and for less contamination by particles.

It is noted that this is a reiteration of the Official Notice made in the last action, and as such is now considered to be prior art.

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*Allowable Subject Matter*

9. Claims 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

10. Applicant's arguments filed 3/2/05 have been fully considered but they are not persuasive.

With regards to the Terminal Disclaimer filed 3/2/05, no fee has been recorded as being paid, therefore the Terminal Disclaimer has not been approved.

11. It is the assertion of the applicant that Hillger and Carden both disclose agitators that are deployed within wellbores and not within "subsurface cavities". Examiner agrees with this assertion, but notes however, that a wellbore falls within the domain of a broad interpretation of the term subsurface cavity. According to Webster's Collegiate Dictionary, 10<sup>th</sup> edition, the term cavity is defined as "an unfilled space within a mass". Thus a wellbore is considered to be a subsurface unfilled space within the earth.

*Conclusion*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

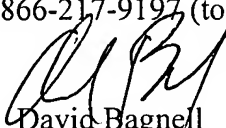
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Stephenson whose telephone number is (571) 272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

DPS 